

Obviousness. With respect to claims 38 and 39, the Examiner has rejected those claims as obvious over Madden in view of French et al. (US 6,308,565).

The problems which Applicant's invention solves existed at the time of invention despite the Madden reference. Specifically, offensive route adjustment and defensive alignment features were added to the Madden NFL game in 2004, well after the instant application was filed. See Madden NFL development entry from Wikipedia (attached hereto as Exhibit 1 and incorporated herein by reference) p. 3. Prior to Madden NFL 2004, the user could only call one of four available "hot routes." See Exhibit 1 p. 3. However, even with the release of Madden NFL 2004, the user only had four additional "hot routes." See Exhibit 1 p. 3. In addition, because of the inability to adjust the defensive alignment, the game was unbalanced in favor of the offensive player in Madden NFL 2004. See Exhibit 1 p. 3.

In Madden NFL 2005, Electronic Arts ("EA"), the creator of the Madden NFL game series, added a defensive "playmaker tool," which allows the defensive player to make pre-snap defensive adjustments and a feature that allowed players to shift formation pre-snap without actually changing the play. Exhibit 1, p. 3. To balance out the defensive bias created by this feature, EA added a feature that resulted in defensive players tiring out more quickly when shifting formation. This feature, however, caused problems in that it allowed offensive players to call multiple formation shifts, which resulted in abnormal decay of the defensive players' energy level, resulting in the defensive players being too "exhausted" to keep out, and forcing multiple defensive character substitutions, which created additional unbalance. Although the defensive "fatigue penalty" feature can be turned off, doing so results in an "unbalanced" and "unrealistic" game. See Exhibit 1, p. 3. The present invention overcomes these shortcomings.

In 2006 EA added a tackle-breaking feature for offensive players and provided a “rookie” player training feature which includes an IQ test, interviews, workouts, the NFL drafting process, hiring of an agent, and other aspects of a professional football player’s career. See Exhibit 1, p. 4. Also in 2006 EA added a cone-shaped spotlight feature emanating from the quarterback during passing plays, simulating the quarterback’s field of vision, which affects his pass rate and pass accuracy. The size of the quarterback’s vision directly correlates to his Awareness and Passer Accuracy rating. Exhibit 1 p. 4. Furthermore, specific defense assignments were not allowed until the 2006 release of Madden. Exhibit 1 p. 4. The present invention solved these problems years earlier.

In 2007 EA added a feature to allow users to control blockers during running plays. In addition in 2007, EA refined the tackle-breaking feature to allow running backs perform different running moves and combos, instead of just “bowling over” defensive players. Also, EA introduced “smart routes” on offense in 2007. Prior to that release, receivers only ran the routes they were assigned, and the only change that could be made was to change the entire route. With the 2007 release, the player could have the receiver adjust their route to go past the first down marker. See Exhibit 1 p. 4. The 2007 release also gave the receiver limited choices over the routes he would take, some choices subjectively being better than others just as in a human game. The present invention solved these problems years earlier.

In the 2008 release, other features were added which gave certain (preprogrammed) players near-Superhero abilities, for example near-record speed/agility etc. See Exhibit 1 p. 5. The present invention solved these problems years earlier.

Madden NFL 2009 contained a series of mini-games presented in a futuristic, hologram style that allows the player to practice various skills which is used to control the game's difficulty. See Exhibit 1 p. 5. The present invention solved these problems years earlier.

All of the added features of the post-2002 releases of Madden NFL, and continuing, show that there is still no way for users to enter players and player data directly: in 2007 the "Superhero" abilities are specifically linked to particular players preprogrammed into the game, and individual player data still cannot be entered directly but rather is "earned" by playing the "mini-games." It was the Applicant, rather than EA, who provided the art for all the features disclosed in the post-2002 Madden releases. This is particularly important, the specification points out (in Par. 0006) because "the outcome of plays based upon individual players in specific positions utilizing the attributes for these players [was] not contemplated" at the time the application was filed. In addition, "the prior art does not provide any means for player training without resorting to actual practice ... where the players are exposed to injuries" (Par. 0006). In Applicant's invention, the outcome of plays based upon individual players in specific positions utilizing the attributes for these players is provided for, and, most importantly, provides a means for player training without resorting to actual practice and exposing players to injuries.

It is incorrect to characterize Madden as facilitating the training of a player under simulated game conditions (claim 38) and presenting a team's formations and plays and opponent's likely actions or reactions thereto: as described in Exhibit 1 and in the arguments herein which are incorporated herein by reference, EA was unable to solve that problem until years after the present application was filed.

Rejecting an application on the basis of obviousness by picking out isolated features in references, combining them in one particular way with the application of hindsight acquired only

from the applicant's own disclosure, and then saying that it would have been obvious to select those particular features and to combine them in the particular way in which the applicant has is inappropriate. *Eversharp, Inc. v. Fisher Pen Co.*, 204 F.Supp 649, 662-63 (N.D. Ill. 1961). It is also impermissible within the framework of 35 U.S.C. § 103 to pick and choose from a reference only so much of it as will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of what the reference fairly suggests to one skilled in the art. *Id.* at 419. *See also In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In the present case, the examiner has cited merely a few lines of the French reference and rejects the application in light of Madden, which is inappropriate. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

In addition, when the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination. *See Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068 (Fed. Cir. 1994); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990). The mere fact that the prior art MAY be modified as the examiner suggests does not make the modification obvious. *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). The question is not whether what is claimed could have been done, but whether it was obvious to do so in light of all the relevant factors. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 19 F.3d 953, 957 (Fed. Cir. 1997). Absent suggestion or motivation, the mere existence of the individual elements at the time of invention does not render a patented combination of these elements obvious as a matter of law. *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004); *Remcor Products Co. v. Scotsman Group, Inc.*, 860 F.Supp. 568 (N.D. Ill. 1994). As stated earlier, French only contemplates tracking performance, and Madden still

cannot solve the problems the present invention addresses, even with obvious commercial success of its rudimentary game since the present application was filed.

Furthermore, the suggestion or motivation to combine prior art teachings must come from prior art and not from the patent application. *See W.L. Gore & Assoc. Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). It is improper to use hindsight reconstruction by using the applicant's own disclosure as a "guide through the maze of prior art references, combining the right references in the right way to achieve the result" the applicant claims. *Orthopedic Equipment Co. Inc. v. U.S.*, 702 F.2d 1005, 1012 (Fed. Cir. 1983); *see also Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988).

To support a rejection under § 103 based on a combination of prior art references, there must be a finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of the claimed invention to make the combination in the manner claimed. *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000). Conjectural modification of a prior art disclosure which is unwarranted by such disclosure is improper. *Carl Schenck, A.G. v. Nortron Corp.*, 713 F.2d 782 (Fed. Cir. 1983). *KSR Teleflex* outlines rationales for combining references:

A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.... It can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does . . . because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. . . . The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.



*KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Furthermore, it is insufficient to show merely that each separate element of a claimed combination can be found in one or more references. *Canadian Ingersoll-Rand Co. v. Peterson Products of San Mateo, Inc.*, 223 F.Supp. 803 (N.D. Cal. 1963), judgment aff'd in part, rev'd in part on other grounds, 350 F.2d 18 (9<sup>th</sup> Cir. 1965). The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. *In re Gergen*, 873 F.2d 1452 (Fed. Cir. 1989); *In re Grabiak*, 769 F.2d 729 732 (Fed. Cir. 1985); *Application of Bergel*, 292 F.2d 955 (1961).

It is improper to use the instant patent application as a guide through the maze of references, essentially engaging in "Monday morning quarterbacking" by combining the right references in the right way to achieve the result as claimed by the examiner. *See Orthopedic Equipment Co., Inc. v. U.S.*, 702 F.2d 1005, 1012 (Fed. Cir. 1983). A combination of elements may be patentable whether it is composed of elements that are all new, partly new, or all old. *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540 (Fed. Cir. 1984). There should be some teaching, or at least suggestion, in the references that the individual elements should be combined as claimed. *In re Demarche*, 219 F.2d 952 (C.C.P.A. 1955); *Application of Regel*, 526 F.2d 1399, 1403 (C.C.P.A. 1975); *Glaros v. H.H. Robinson Co.*, 600 F.Supp. 342, 349 (N.D. Ill. 1984), judgment aff'd, 797 F.2d 1564 (Fed. Cir. 1986), cert dismissed, 479 U.S. 1072 (1987); *Ex parte Chicago Rawhide Mfg. Co.*, 223 U.S.P.Q. (BNA) 351, 353 (Pat. & Trademark Office Bd. App. 1984). There was no such suggestion in the references.

To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed combination, or the

examiner must present a convincing line of reasoning as to why the inventor would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. (BNA) 972, 973 (Bd. Pat. App. & Interferences 1985); *see also Application of Ehrreich*, 590 F.2d 902, 908 (C.C.P.A. 1979); *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986).

The mere fact that the references originate from the same art or that the disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); *Application of Imperato*, 486 F.2d 585, 587 (C.C.P.A. 1973). *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988).

There is no presumption that everything disclosed in a patent has been invented by the applicant(s) therefore. *Aktiebolaget Karlstads Mekaniska Werkstad v. U.S. Intern. Trade Com'n*, 705 F.2d 1565, 1574 (1983). The question is always whether one skilled in the art, with the references before him, could make the combination of elements claimed without the exercise of inventive faculty. *Application of Shaffer*, 43 C.C.P.A. 758 (1956); *Application of Carter*, 41 C.C.P.A. 851 (1954); *see also Application of Way*, 514 F.2d 1057, 1062 (C.C.P.A. 1975). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. *In re Fine*, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

The test under 35 U.S.C. § 103 is not whether an improvement or a use set forth in a patent would have been obvious or nonobvious; rather the test is whether the claimed invention, *considered as a whole*, would have been obvious. *See, e.g., Jones v. Hardy*, 220 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984). Thus it is impermissible to focus either on the “gist” or “core” of the invention (*Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986), *cert. denied*, 484 U.S. 823 (1987)), or on specific differences between the claimed

invention and the prior art (*Jones*, 220 U.S.P.Q. at 1024).

In the present case, none of the references cited refer to each other or contemplate combination with the other references. Applicant solved problems with this invention that EA is still unable to solve. With respect to the French reference, the invention is specifically geared towards measurement of one player's performance of different skills including "posture and balance control, agility, power and coordination" (col. 1, ll. 35-36). French is geared towards "quantifying physical motion of a player or subject and providing feed back to facilitate training and athletic performance" (col. 4 ll. 30-32). The invention works by creating "realistic movement challenges for the player . . . typically comprised of relatively short, discrete movement legs, sometimes amounting to only a few inches of displacement of the player's center of mass" (col. 4 ll. 52-55). Furthermore, there is no fixed start or end position for the "movement challenges," requiring continual tracking of the player's position for meaningful assessment (col. 4 ll. 55-57). Data other than "physical motion of a player" and the player's physical location in space is irrelevant in French. French is expected to work by exposing the player to "dynamic" movement cues including "continual abrupt explosive changes of direction and maximal accelerations and decelerations over varying vector directions and distances" (col. 5 ll. 14-48).

The present invention, however, uses a wide variety of "vital statistics" and "attributes which predict athletic performance associated therewith." French does not contemplate or achieve any purpose other than measuring one player's performance. The present invention, on the other hand, "begins by entering players for positions in a squad on an offensive, defensive or special team," necessarily includes a wide range of player-specific data and progresses through an entire play, among other things (Par. 0009). In addition, French merely tracks the player's

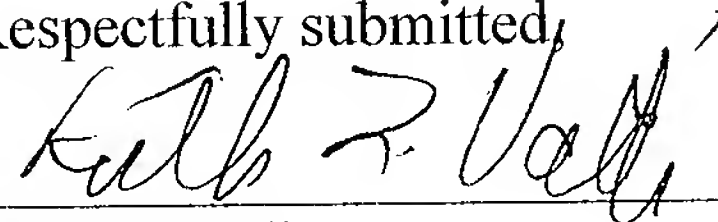


movements passively, whereas the present invention establishes a play based on players in formation “in which the moving pattern and activity of each player is defined . . . then simulated by having each player executing the moving pattern and activity as modified by the vital statistics [and other attributes] associated with each player” (Par. 0009). Clearly there is no suggestion in the cited references to combine the elements of the present invention in the way the inventor has done. Accordingly, the present invention was not obvious at the time of invention and Applicant respectfully requests that the application be allowed to issue.

The above arguments are made without waiving any rights as to alternate theories of patentability.

03-24-09  
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Respectfully submitted,



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